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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Scott A. Cluff et al.	§	Group Art Unit:	2114
Serial No.:	09/706,960	§		
		§	Examiner:	Gabriel L. Chu
Filed:	November 6, 2000	§		
For:	Recovering a System that has Experienced a Fault	§	Atty. Dkt. No.:	MCT.0133US (MUEI-0548.00/US)

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Sir:

This Reply Brief is in response to the Examiner's Answer dated July 21, 2005.

A. RESPONSE TO EXAMINER'S COMMENT REGARDING GROUPING OF CLAIMS IN HEADING (7) OF THE ANSWER

The Examiner stated that the "rejection of claims under their respective grounds stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 C.F.R. 1.192(c)(7)." Examiner's Answer at 3.

Appellant notes that the citation of 37 C.F.R. § 1.192 is to the old rules regarding appeals. The present appeal is subject to the new rules under 37 C.F.R. § 41.37. *See* Official Gazette Notice (attached) (any appeal brief filed after effective date of September 13, 2004, is subject to

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I hereby certify under 37 CFR 1.8(a) that this correspondence is being deposited with the United States Postal Service as **first class mail** with sufficient postage on the date indicated above and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313.

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content and format requirements of § 41.37(c). As a result of these rules changes, 37 C.F.R. § 1.192 was removed. Therefore, the new appeal rules require that the content and format of the appeal brief be consistent with § 41.37(c), not § 1.192(c), as indicated in the Examiner's Answer.

The new appeal rules have removed the grouping of claims requirement set forth in former Rule 192(c)(7). *See* Federal Register, Vol. 69, No. 155, at 49962 (attached). New rule § 41.37(c)(1)(vii) specifies that "[f]or each ground of rejection applying to two or more claims, the claims may be argued separately or as a group." Rule § 41.37(c)(1)(vii) further states:

> Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number.

There is no requirement under § 41.37 that a statement be provided that one or more claims stand or fall together. The arguments presented in the Appeal Brief are consistent with the requirements of § 41.37(c), where groups of claims are placed under separate subheadings and argued separately. Therefore, the indication in the Examiner's Answer that the rejections of claims under their respective grounds stand or fall together is in error.

B. RESPONSE TO EXAMINER'S COMMENT REGARDING CLAIMS 1, 2, 9-11, 28, 30, 31, AND 33 IN HEADING (11).1 AND (11).2 OF THE ANSWER

In response to Appellant's arguments that the Examiner has failed to establish a *prima facie* case of obviousness with respect to independent claim 1 over Halladay in view of Reynolds, the Examiner modified the obviousness rejection over Halladay and Reynolds to focus on different parts of Halladay (Examiner's Answer at 4), and provided further arguments responding to Appellant's Appeal Brief. *Id.* at 15.

The Examiner now focuses on the statement made in the abstract of Halladay that the cold boot data backup apparatus "automatically" formats the computer system memory in

response to a failure thereof and "automatically" restores the operating system, all application programs, and every data file that is selected by the user to be monitored and preserved by the apparatus. The Examiner argued that the disclosure in Halladay that the cold boot backup apparatus automatically formats computer system memory and automatically restores certain components provides the requisite suggestion to combine Halladay with Reynolds to achieve the claimed invention.

It is respectfully noted that the Examiner has taken this teaching of Halladay out of context. For example, in column 7 of Halladay, a discussion of the flow diagram in Figs. 5 & 6 of Halladay is provided. Starting at line 28 in column 7, Halladay states that the cold boot backup system "automatically" recreates the state of memory of a computer system by formatting the newly installed computer system memory and then identifying, locating, and loading all application programs from a backup media 21 to the computer system memory. Halladay, 7:28-36. However, it is clear from Figs. 5 and 6 of Halladay that the failure recovery process of Halladay is initiated by a user. Fig. 5 depicts various boxes, including a "user navigates ID file system" box 51, a "user selects file states to restore" box 52, a "user wants to restore more files?" diamond 53, a "present file states to user" box 54, a "user wants to exclude file states?" diamond 55, and a "user excludes file states" box 56. Fig. 6 depicts a "present completion status to user" box 62, and various boxes regarding the removal of a tape, mounting of a tape, dismounting of a tape, and so forth. Column 8 of Halladay further states that the cold boot process is "typically initiated by the user in response to the failure of the hard drive ..." Halladay, 8:22-23. The column 8 passage also teaches that the user "initiates the cold boot process ... by loading the cold boot floppy disk into the floppy drive for the computer system at

step 81." Halladay, 8:25-28. Column 8 of Halladay also teaches that "the user boots the computer system 1" to perform additional tasks. Halladay, 8:28-30.

After the *user* has performed the above steps, the computer system of Halladay identifies an auto_exec.bat file on the floppy disk and reads the file to direct the computer system to a cold boot application program that is written on the floppy disk. Halladay, 8:30-37. In response to executing the cold boot application program, the computer system is instructed to run the disk format operation and then performs the hard drive restore process to populate the hard drive with application programs and application data. Thus, the "automatic" feature indicated in the Abstract of Halladay refers to what the cold boot application program performs *after* the user has determined that a cold boot process is needed and has loaded the cold boot floppy disk into the floppy drive of the computer system.

Thus, the focus of the Examiner on the word "automatic" in the Abstract of Halladay without regard to the actual context taught in columns 7 and 8 of Halladay is improper. The teachings of the entire reference should be reviewed to determine the true teachings of the reference. Here it is clear that Halladay teaches that a floppy disk is loaded by a user into a floppy drive of a computer system to start the cold boot process after a failure has occurred. There is absolutely no hint of any desirability of using the flag recited in claim 1 – namely, there is no suggestion provided by Halladay to a person of ordinary skill in the art to use any type of flag, including the flag of Reynolds, to cause a backup device to enable access of the network through an interface in response to the flag indicating failure of the first operational element, as recited in claim 1.

Moreover, as discussed in the Appeal Brief, the teachings of Reynolds are clearly unrelated to the teachings of Halladay. Reynolds is concerned about entering a fail-safe mode

based on a special flag, where the fail-safe mode includes a reduced set of graphical features. Reynolds, 3:31-55. Reynolds clearly is not concerned about restoring data from a backup device as is the case with Halladay. Thus, a person of ordinary skill in the art looking at the teachings of Reynolds would not have been motivated to apply the special flag (completely unrelated to restoring data on a storage device) to the system of Halladay.

Without the benefit of the disclosure of the present invention, a person of ordinary skill in the art would not have been led to combine the unrelated elements of the references to achieve the claimed invention. *See, e.g., In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988) ("One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."); *In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992) ("It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious.").

Thus, clearly, no motivation or suggestion existed to combine the teachings of Halladay and Reynolds to achieve the claimed invention.

Also, as argued in the Appeal Brief, the hypothetical combination of Halladay and Reynolds does not disclose the flag of claim 1, which flag indicates the fault has occurred with a first operational element, in combination with the flag causing the backup device to enable access of the network through the interface.

The *prima facie* case of obviousness is defective for the reasons stated above.

C. RESPONSE TO EXAMINER'S COMMENT REGARDING CLAIMS 4, 14, AND 20 IN HEADING (11).3 OF THE ANSWER

The Examiner argued that the term "browser" should mean "simply something used for browsing." Examiner's Answer at 16. Note that claim 4 depends from claim 3, which recites that the backup device comprises a backup storage element containing a backup routine adapted to *perform communications through the network stack including the IP (Internet Protocol) layer to the network.* Claim 4 further defines that this backup routine comprises a browser. Thus, the term "browser" is not just any browser – it must be a browser that is adapted to perform communications through a network stack including the IP layer to the network. The various dictionary definitions cited by the Examiner actually support Appellant's arguments made in the Appeal Brief that "browser" must refer to a "web browser." In the Wikipedia Free Encyclopedia cited by the Examiner, the term "browser" was cited as being able to refer to a "type of herbivore whose nutrition generally comes from high growing plants," a "code browser" to access code units in a computer program, a "file browser" to access information on a file system, a "help browser" to access help information within an operating system, or a "web browser" to access information on the World Wide Web. Clearly, in the context of claims 3 and 4, the only definition that is applicable to "browser" is the "web browser" in the Wikipedia Free Encyclopedia.

The Merriam-Webster Online Dictionary cited by the Examiner provides two definitions for "browser": (1) one that browses; and (2) a computer program used for accessing sites or information on a network (as the World Wide Web). The first definition is so general that it clearly has no applicability to the term "browser" in the context of claims 3 and 4. The second definition in the Merriam-Webster Online Dictionary is the more applicable one.

In TechEncyclopedia, the term "browser" was defined as a "program that lets you look through a collection of data." There is no indication here that such a program is able to perform communications through a network stack including the IP layer. The definition in the TechEncyclopedia also refers to the definition for "web browser" and other types of browsers. Again, it is clear that in the context of claims 3 and 4, the term "browser" refers to a "web browser."

Since none of Halladay, Reynolds, or Stevens teaches the browser as recited in claim 4, it is respectfully submitted that the hypothetical combination of Halladay, Reynolds, and Stevens does not teach or suggest all elements of claim 4 -- therefore, a *prima facie* case of obviousness has not been established with respect to claim 4.

Similarly, the hypothetical combination of Halladay and Stevens does not teach or suggest the subject matter of claims 14 and 20.

D. RESPONSE TO EXAMINER'S COMMENT REGARDING CLAIMS 3, 5-7, AND 32 IN HEADING (11).4 OF THE ANSWER

With respect to the rejection of these claims, Appellant stands by the position that no motivation or suggestion existed to combine the teachings of Halladay, Reynolds, and Stevens. The Examiner cited additional references regarding TCP/IP. Examiner's Answer at 17. However, such teachings regarding TCP/IP do not change the fact that no motivation or suggestion existed to incorporate TCP/IP into Halladay and Reynolds to achieve the claimed invention.

E. CONCLUSION

In view of the above arguments and the arguments set forth in the Appeal Brief, reversal of all final rejections is respectfully requested.

Respectfully submitted,

Date: 9-20-2005

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Clarification of the Effective Date Provision in the Rules of Practice before the Board of Patent Appeals and Interferences (Final Rule)

The effective date provision in the Rules of Practice before the Board of Patent Appeals and Interferences (Final Rule) (hereinafter BPAI final rule) states that September 13, 2004 is the effective date. See Rules of Practice Before the Board of Patent Appeals and Interferences (Final Rule), 69 Fed. Reg. 49959 (August 12, 2004). The U.S. Patent and Trademark Office (Office) has received inquiries as to how the effective date provision applies to certain situations. This notice provides clarification as to how the Office is implementing the effective date provision.

Generally, any paper filed by applicants or mailed by the Office on or after September 13, 2004 must comply with the rules as set forth in the BPAI final rule. Appeal briefs filed prior to September 13, 2004 must either comply with former § 1.192 or new § 41.37. A certificate of mailing or transmission in compliance with § 1.8 will be applicable to determine if a paper was filed prior to the effective date of September 13, 2004 in order to determine which rule applies. Examples of certain situations are set forth in the questions and answers below. Additional questions and answers concerning the BPAI final rule are available on the USPTO web site at www.uspto.gov.

Questions related to Time Periods for Filing of Papers Related to After Final Practice and *Ex Parte* Appeals:

Question 1. If a notice of appeal is filed before September 13, 2004, the effective date of the BPAI final rule, when is the appeal brief due?

If the notice of appeal is filed before September 13, 2004, the time period for filing an appeal brief will be the time period set forth in former § 1.192(a) which provides that the appellant must file an appeal brief: (1) within two months from the date of filing of the notice of appeal; or (2) within the time allowed for reply to the action from which the appeal was taken, if such time is later.

The time period set forth in former § 1.192(a) also applies if the notice of appeal is filed with a certificate of mailing or transmission in compliance with § 1.8 and the date on the certificate of mailing or transmission is before the effective date of September 13, 2004, but the notice of appeal is received by the Office on or after September 13, 2004. The two month time period will begin on the date of receipt of the notice of appeal.

Question 2. If appellant reinstates the appeal after the prosecution is reopened by filing a second notice of appeal on or after the effective date, when is the second appeal brief due?

Appellant must file the second appeal brief (in compliance with the format and content requirements of § 41.37(c)) within two months from the date of filing the second notice of appeal, even if the first notice of appeal and the first brief were filed before the effective date. The two month time period is extendable under the provisions of § 1.136 for patent applications and § 1.550(c) for *ex parte* reexamination proceedings. See § 41.37(e).

Question 3. If a notice of appeal is filed on or after the effective date of September 13, 2004, would extensions of time under § 1.136(a) be required when a Request for Continued Examination (RCE) under § 1.114 or an amendment is filed after two months from the date of filing the notice of appeal, but within three months from the mailing of the action from which the appeal was taken?

Yes, extensions of time under § 1.136(a) are required for filing an RCE or amendment after two months from the filing of the notice of appeal, even if the RCE or amendment is filed within the three months from the mailing of the action from which the appeal was taken.

Questions related to Appeal Brief Contents or Requirements for Papers Filed after Appeal:

Question 4. If the notice of appeal is filed before the effective date of September 13, 2004 and the brief is filed by appellant on or after the effective date, would the appeal brief be required to comply with the content and format requirements of § 41.37(c)?

Yes, any appeal brief filed on or after September 13, 2004 must be in compliance with the requirements set forth in § 41.37(c) and be accompanied by the appropriate fee under § 41.20(b)(2). If the brief does not comply with § 41.37(c), an amended brief will be required under § 41.37(d).

Exception: If the appeal brief is filed with a certificate of mailing or transmission under § 1.8 and the date on the certificate of mailing or transmission is before September 13, 2004, the appeal brief may comply with either former § 1.192 or new § 41.37, even if the appeal brief is received by the Office on or after September 13, 2004.

Question 5. Would the Office accept an appeal brief filed before the effective date of September 13, 2004 that is in compliance with § 41.37(c)?

Yes, a brief filed before September 13, 2004 that is compliant with the new § 41.37(c) will be acceptable.

Question 6. If an appeal brief filed before the effective date of September 13, 2004 fails to comply with the content and format requirements of § 1.192 and the Office mails appellant a Notice that correction is required, would an amended appeal brief filed on or after the effective date be required to be in compliance with § 41.37(c)?

No, an amended appeal brief, based on an appeal brief originally filed prior to September 13, 2004, would be acceptable if it complies with either former § 1.192 or § 41.37(c), regardless of when the Office mailed a Notice requiring correction of the noncompliant appeal brief.

Question 7. If, after a final rejection or an appeal, applicant or appellant filed an amendment, affidavit or other evidence on or after the effective date, will the revised or new rules in the BPAI final rule apply?

Any affidavit or other evidence filed after a final rejection, or an appeal, on or after the effective date, will be subject to the revised or new rules (*i.e.*, the revised § 1.116 or new § 41.33).

Questions related to Examiner's Answers and Supplemental Examiner's Answers:

Question 8. If the appeal brief is filed before the effective date of September 13, 2004, but the examiner's answer is mailed on or after the effective date, can the examiner's answer include a new ground of rejection?

Yes, an examiner's answer mailed on or after September 13, 2004 may include a new ground of rejection (with Technology Center Director or designee approval) in compliance with § 41.39. Any examiner's answer mailed before September 13, 2004, however, may not include a new ground of rejection. See former § 1.193.

Question 9. Can the examiner provide a supplemental examiner's answer under § 41.43 on or after the effective date of September 13, 2004 in response to any new issue raised in a reply brief that was filed before the effective date?

Yes, the examiner may provide a supplemental examiner's answer (with Technology Center Director or designee approval) if it is mailed on or after September 13, 2004 in response to any new issue raised in a reply brief, even if the reply brief was filed before September 13, 2004. Appellant may file another reply brief in compliance with § 41.41 to reply to the supplemental examiner's answer within two months from the date of mailing of the supplemental examiner's answer. Extensions of time under § 1.136(a) are not applicable to the two-month time period.

Question 10. If the Board remanded an application before the effective date of September 13, 2004 for <u>further consideration of a rejection</u>, and the examiner provides a supplemental examiner's answer on or after the effective date (in response to the remand by the Board), can appellant request that prosecution be reopened under § 41.50(a)(2)(i)?

No, appellant may <u>not</u> request that prosecution be reopened under § 41.50(a)(2)(i) in response to the supplemental examiner's answer since the Board remanded the application before the effective date. Appellant may request that prosecution be reopened in response to a supplemental examiner's answer written in response to the remand by the Board, only if: (1) the remand is on or after the effective date, and (2) the remand is for further consideration of a rejection. The Board should indicate in the remand if § 41.50(a)(2)(i) applies. Thus, appellant may <u>not</u> request that prosecution be reopened under § 41.50(a)(2)(i) if the remand is for another reason.

FOR FURTHER INFORMATION CONTACT: Kery Fries, Senior Legal Advisor in the Office of Patent Legal Administration, by telephone at (703) 308-6906 or (571) 272-7704 on or after September 29, 2004, or by e-mail addressed to Kery.Fries@USPTO.gov.

/s/ Robert J. Spar, for
Stephen G. Kunin
Deputy Commissioner
for Patent Examination Policy

application for a patent, an application for reissue of a patent, or an ex parte reexamination proceeding to the Board.

Section 41.30 sets forth definitions for Board proceedings under subpart B of part 41. The preamble to § 41.30 is based on a similar provision in the preamble of former Rule 601. The term "proceeding" sets forth a generic term for a national application for a patent, an application for reissue of a patent, and an ex parte reexamination proceeding. The term "applicant" sets forth a generic term for either the applicant in a national application for a patent or the applicant in an application for reissue of a patent. The term "owner" sets forth a shorthand reference to the owner of the patent undergoing ex parte reexamination under Rule 510.

Section 41.31 is added to generally incorporate the requirements of former Rule 191(a)–(d). Paragraph (a) is subdivided into three parts to improve readability. Paragraph (d) is amended to refer only to the time periods referred to in paragraphs (a)(1)–(a)(3) of this section, while the current extension of time requirements for Rules 192, 193, 194, 196 and 197, formerly provided in Rule 191(e), is relocated to §§ 41.37, 41.41, 41.47, 41.50 and 41.52.

Section 41.33 is added to replace the requirements of former Rules 116 and 195. Paragraph (a) provides that amendments filed after the date of filing an appeal pursuant to § 41.31(a)(1)–(a)(3) and prior to the date a brief is filed pursuant to § 41.37 may be admitted as provided in § 1.116. Thus, amendments after final but prior to appeal and amendments filed after appeal but prior to the date the brief is filed will be treated under the same standard (i.e, § 1.116). Paragraph (b) provides that amendments filed on or after the date of filing a brief pursuant to § 41.37 may be admitted: (1) to cancel claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, or (2) to rewrite dependent claims into independent form. A dependent claim is rewritten into independent form by including all of the limitations of the base claim and any intervening claims. Thus, no limitation of a dependent claim can be excluded in rewriting that claim into independent form. Paragraph (c) provides that all other amendments filed after the date of filing an appeal pursuant to § 41.31(a)(1)–(a)(3) will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i), 41.50(b)(1) and 41.50(c). Paragraph (d)(1) provides that affidavits or other evidence filed after the date of filing an appeal pursuant to § 41.31(a)(1)–(a)(3) and prior to the date of filing a brief pursuant to § 41.37 may be admitted if the examiner determines that the affidavits or other evidence overcomes all rejections under appeal and that there is a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. Paragraph (d)(2) provides that all other affidavits or other evidence filed after the date of filing an appeal pursuant to § 41.31(a)(1)–(a)(3) will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i) and 41.50(b)(1). Paragraph (d) replaces the former practice of permitting such evidence based on a showing of good and sufficient reasons why such evidence was not earlier presented set forth in former Rule 195. The Office believes that prosecution should occur before the examiner prior to an appeal being filed, not after the case has been appealed pursuant to § 41.31(a)(1)–(a)(3).

Section 41.35 is added to generally incorporate the requirements of former Rule 191(e). In addition, this section makes clear that jurisdiction over an application may be relinquished by the Board and the application returned to the examining operation to permit processing to be completed by the examining operation before the Board takes up the appeal for decision. This is consistent with the present practice of returning an appealed application to the examining operation where some matter requiring attention has been identified prior to assignment of the appeal number and docketing of the appeal. In addition, the Board is permitted to take other appropriate action to complete the file.

Section 41.37 is added to generally incorporate the requirements of former Rule 192. In addition, the following changes have been made:

(1) The title of the section has been changed from "Appellant's brief" to "Appeal brief".

(2) In paragraph (a), one copy of the brief is required rather than three copies consistent with the Office's move to an electronic file wrapper.

(3) In paragraph (a), the brief is required to be filed within two months from the date of the notice of appeal under § 41.31 even if the time allowed for reply to the action from which the appeal was taken is later, which overall simplifies docketing of the due date.

(4) In paragraph (c)(1)(i), a statement is required in the brief identifying by name the real party in interest even if the party named in the caption of the brief is the real party in interest. This provides appellant the necessary mechanism for complying with § 41.8(a) in an appeal to the Board.

(5) In paragraph (c)(1)(ii), identification is required of all other prior and pending appeals, interferences or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal, as well as to set forth a mechanism for complying with § 41.8(b) in an appeal to the Board.

(6) In paragraph (c)(1)(iii), both a statement of the status of all the claims in the proceeding (*e.g.*, rejected, allowed or confirmed, withdrawn, objected to, canceled) and an identification of those claims that are being appealed is required.

(7) In paragraph (c)(1)(v), a concise explanation of the invention is required for each of the independent claims involved in the appeal, which explanation shall refer to the specification by page and line number, and to the drawings, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. The former requirement of Rule 192(c)(5) to set forth a concise explanation of the invention defined in the claims involved in the appeal by reference to the specification by page and line number, and to the drawings, if any, by reference characters was not being followed in a great number of briefs before the Board.

(8) In paragraph (c)(1)(vi), a concise statement listing each ground of rejection presented for review is required rather than issues for review. An example of a concise statement is "Claims 1 to 10 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. X."

(9) The grouping of claims requirement set forth in former Rule 192(c)(7) is removed. The general purpose served by former Rule 192(c)(7) is addressed in § 41.37(c)(1)(viii). The existing grouping of claims requirement has led to many problems such as (i) Grouping of claims across multiple rejections (*e.g.*, claims 1–9 rejected under 35 U.S.C. 102 over A while claims 10–15 are rejected under 35 U.S.C. 103 over A and the appellant

states that claims 1–15 are grouped together); (ii) Claims being grouped together but argued separately (*e.g.*, claims 1–9 rejected under 35 U.S.C. § 102 over A, the appellant groups claims 1–9 together but then argues the patentability of claims 1 and 5 separately); and (iii) examiners disagreeing with the appellant's grouping of claims.

(10) In paragraph (c)(1)(vii), any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown (requirement found in former Rule 192(a)), and a separate heading is required for each ground of rejection in place of the previous grouping of claims section of the brief. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When an appellant argues as a group multiple claims subject to the same ground of rejection, the Board may select a single claim from that group of claims and treat its disposition of a ground of rejection of that claim as applying to the disposition of that ground of rejection of all claims in the group of claims. Notwithstanding any other provision of this paragraph, an appellant's failure to argue separately claims that the appellant has grouped together constitutes a waiver of any argument that the Board must consider the patentability of any grouped claim separately. *See In re McDaniel*, 293 F.3d 1379, 1384, 63 USPQ2d 1462, 1465–66 (Fed. Cir. 2002) (interpreting former Rule 192(c)(7) to require separate treatment of separately rejected claims). Any claim argued separately should be placed under a subheading identifying the claim by number and claims argued as a group should be placed under a subheading identifying the claims by number. For example, if Claims 1 to 5 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. Y and appellant is only going to argue the limitations of independent claim 1, and thereby group dependent claims 2 to 5 to stand or fall with independent claim 1, then one possible heading as required by this subsection could be *Rejection under 35 U.S.C. 102(b) over U.S. Patent No. Y* and the optional subheading would be Claims 1 to 5. As another example, where claims 1 to 3 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. Z and the appellant wishes to argue separately the patentability of each claim, a possible heading as required by this subsection could be *Rejection under 35 U.S.C. 102(b) over U.S. Patent No. Z*, and the optional subheadings would be *Claim 1*, *Claim 2*, and *Claim 3*. Under each subheading the appellant would present the argument for patentability of that claim.

(11) Paragraph (c)(1)(vii) states that "Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable", a statement in slightly different form appeared in former Rule 192(c)(7).

(12) Paragraph (c)(1)(vii) eliminates subparagraphs (i) through (v) of former Rule 192(c)(8) which related to the manner in which arguments were to be made. Although they provided useful advice as to what an effective argument ought to include, these provisions have often been ignored by appellants and, for the most part, have not been enforced as set forth in paragraph (d) of that rule.

(13) Paragraph (c)(1)(ix) is added to require appellant to include an evidence appendix of any evidence relied upon by appellant in the appeal with a statement setting forth where that evidence was entered in the record by the examiner so that the Board will be able to easily reference such evidence during consideration of the appeal.

(14) Paragraph (c)(1)(x) is added to require appellant to include a related proceedings appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section so that the Board can take into consideration such decisions.

(15) Paragraph (c)(2) is added to exclude any new or non-admitted amendment, affidavit or other evidence from being included in the brief.

(16) Paragraph (d) is added to provide that appellants will be notified of reasons for non-compliance and given a period of time to file an amended brief.

(17) Paragraph (e) is added to provide notice that the periods set forth in this section are extendable under the provisions of Rule 136 for patent applications and Rule 550(c) for ex parte reexamination proceedings. This provision appeared in former Rule 191(d).

Section 41.39 is added to generally incorporate requirements found in former Rule 193(a).

Section 41.39(a)(2) is added to permit a new ground of rejection to be included in an examiner's answer eliminating the former prohibition of new grounds of rejection in examiner's answers. Many appellants are making new arguments for the first time in their appeal brief (apparently stimulated by a former change to the appeal process that inserted the prohibition on new grounds of rejection in the examiner's answer). Because the current appeal rules only allow the examiner to make a new ground by reopening prosecution, some examiners have allowed cases to go forward to the Board without addressing the new arguments. Thus, the revision would improve the quality of examiner's answers and reduce pendency by providing for the inclusion of the new ground of rejection in an examiner's answer without having to reopen prosecution. By permitting examiners to include a new ground of rejection in an examiner's answer, newly presented arguments can now be addressed by a new ground of rejection in the examiner's answer when appropriate. Furthermore, if new arguments can now be addressed by the examiner by incorporating a new ground of rejection in the examiner's answer, the new arguments may be able to be addressed without reopening prosecution and thereby decreasing pendency.

It is envisioned that new grounds of rejection in examiner's answers would be rare, rather than a routine occurrence. The Office plans to issue instructions that will be incorporated into the MPEP requiring that any new ground of rejection made by an examiner in an answer must be personally approved by a Technology Center Director or designee and that any new ground of rejection made in an answer be prominently identified as such. It is the further intent of the Office to provide guidance to examiners that will also be incorporated into the MPEP as to what circumstances, *e.g.*, responding to a new argument or new evidence submitted prior to appeal, would be appropriate for entry of a new ground of rejection in an examiner's answer rather than the reopening of prosecution. Where, for example, a new argument(s) or new evidence cannot be addressed by the examiner based on the information then of record, the examiner may need to reopen prosecution rather than apply a new ground of rejection in an examiner's answer to address the new argument(s) or new evidence.

Paragraph (b) of § 41.39 is added to set forth the responses an appellant may make when an examiner's answer sets forth a new ground of rejection. Appellant is required within two months from the date of the examiner's answer containing a new ground of rejection either:

(1) To request that prosecution be reopened by filing a reply under Rule 111 with or without amendment or submission of affidavits (Rules 130, 131 or 132) or other evidence, which would